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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,699	09/02/2004	John Barry Henshall	PF/3-22628/A/MA 2218/PCT	4708
324 7590 02/21/2007 CIBA SPECIALTY CHEMICALS CORPORATION PATENT DEPARTMENT 540 WHITE PLAINS RD P O BOX 2005 TARRYTOWN, NY 10591-9005			EXAMINER HESS, BRUCE H	
			ART UNIT 1774	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/21/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/506,699

Applicant(s)

HENSHALL ET AL.

Examiner

Bruce H. Hess

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1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12-3-06 (IDS)
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 12-3-06
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

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Claims 1, 2 and 4-9 are rejected under 35 USC 102 (b) as being anticipated by the patent to Shimizu et al. (JP 07-047772) (see applicants' International Search Report).

This patent teaches thermosensitive recording material coated with a composition comprising a color former, a hydroxyl diphenylsulfone color developer and applicants' compounds (II) and/or (III) (see Formulae 3 and/or 4 in Shimizu et al.). Since the aforementioned compounds of Formulae 3 and/or 4 are the same as applicants' compounds (II) and (III), it is inherent that they function in the manner (i.e., color developer) claimed by applicants.

Claims 1, 2 and 4-9 are rejected under 35 USC 102 (b) as being anticipated by the patent to Nishimura et al. (USP 5,292,711).

This patent teaches thermosensitive recording material coated with a composition comprising a color former, a color developer (see column 12, lines 17-31) and applicants' compound (I) (see Formula (I) in Nishimura et al.). Since the aforementioned compound of Formula (I) is the same as applicants' compounds (I), it is inherent that it functions in the manner (i.e., color developer) claimed by applicants.

Claims 1, 2 and 4-9 are rejected under 35 USC 102 (b) as being anticipated by the patent to Takahashi et al. (USP 5,314,859).

This patent teaches thermosensitive recording material coated with a composition comprising a color former, applicants' compound (1) (see Formula (IV) in Shimizu et al.) as an additive and a color developer (see column 15, lines 13-39). Since the

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aforementioned compound of Formula (IV) is the same as applicants' compound (I), it is inherent that it functions in the manner (i.e., color developer) claimed by applicants.

A handwritten signature in black ink, appearing to read "Bruce Hess". The signature is fluid and cursive, with the first name "Bruce" and the last name "Hess" clearly distinguishable.

BRUCE H. HESS  
PRIMARY EXAMINER  
GROUP 1300